

REMARKS

The applicant notes with appreciation the acknowledgement of the claim for priority under section 119 and the notice that all of the certified copies of the priority documents have been received.

The applicant acknowledges and appreciates receiving an initialed copy of the form PTO-1449 that was filed on March 26, 2004. However, it appears that a reference on the form PTO-1449 was inadvertently not initialed. Therefore, a Request for Return of Initialed Form PTO-1449 is filed herewith.

Claims 1 – 13 are pending. New claims 5 – 13 have been added. The applicant respectfully requests reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1 – 4 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,581,028, Barth et al. (“Barth”). Claim 1 has been amended. Support for the amendment is located in the specification as filed, for example, page 9, lines 1 – 31; FIGs. 1A-1C and 2A-2C. Insofar as the rejection may be applied to the claims as amended, the rejection is respectfully traversed for reasons including the following, which are provided by way of example.

The specification recognizes the problem of providing “a semiconductor sensor having a membrane structure, capable of preventing the destruction of a membrane, caused by the expansion and/or contraction of a fluid within a hollow part formed under the membrane, while the sensor is in use.” (Specification page 5, lines 1 – 5.)

Independent claim 1 as amended recites, for example, “a substrate; a membrane ... formed on a top surface of the substrate; and ... a hollow part is formed under the membrane by bonding a bottom of the substrate and a mounting surface on which the semiconductor sensor is

mounted; ... the pressure difference adjusting means is at least a relief hole, provided on the membrane, for the expansion or contraction of a fluid within the follow part, only the at least a relief hole communicating the hollow part to an outside of the semiconductor sensor.” (See also independent claim 10.) Consequently, when a hollow part is formed by sealing a sensor to a stem, the relief hole(s) formed on the membrane can prevent the membrane from expanding or contracting in use.

Without conceding that Barth discloses any feature of the present invention, Barth relates to “fluid flow sensors and actuators.” Barth discloses a flow sensor in which a sensing element has a bridging structure and an outlet therebelow. Fluid flow is sensed as fluid flows from the “inlet” 172 to the “outlet” 182.

The office action asserts that Barth discloses the invention as claimed. To the contrary, Barth fails to teach or suggest the invention, as presently claimed, when the claims are considered as a whole. Barth fails to teach or suggest, for example, the pressure difference adjusting means for eliminating difference in pressure while the sensor is in use. To the contrary, Barth teaches sensing the flow rather than eliminating the differences in pressure.

Moreover, Barth fails to teach or suggest that only the membrane has the at least a relief hole provided thereon. To the contrary, Barth has additional elements. (See, e.g., FIG. 9.)

In addition, with respect to the recited pressure difference adjusting means, the applicant respectfully traverse the examiner’s treatment of this language in the office action. Regarding means plus function language, the Court of Appeals for the Federal Circuit, in its *en banc* decision *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), held that:

Per our holding, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification

corresponding to such language when rendering a patentability determination. (Emphasis added.)

Therefore, a "means or step plus function" limitation should be interpreted in a manner consistent with the specification disclosure. The Federal Circuit explained the two step analysis involved in construing means-plus-function limitations in *Golight Inc. v. Wal-Mart Stores Inc.*, 355 F.3d 1327, 1333-34, 69 USPQ2d 1481, 1486 (Fed. Cir. 2004): "The first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. ... The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function." (*Id.*; citations omitted.) Here, the examiner has failed to consider the first step or the second step.

The MPEP requires that the examiner must find that a prior art element: (A) performs the function specified in the claim, (B) is not excluded by any definition provided in the specification for an equivalent, and (C) is an equivalent of the means-plus-function limitation. Factors that will support a conclusion that the prior art element is an equivalent are: (1) the prior art element performs the identical function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification. *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000); (2) a person of ordinary skill in the art would have recognized the interchangeability of the element shown in the prior art for the corresponding element disclosed in the specification. *Caterpillar Inc. v. Deere & Co.*, 224 F.3d 1374, 56 USPQ2d 1305 (Fed. Cir. 2000); (3) there are insubstantial differences between the prior art element and the corresponding element disclosed in the specification. *IMS Technology, Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1436, 54 USPQ2d 1129, 1138 (Fed. Cir. 2000); (4) the prior art element is a structural equivalent of the corresponding element disclosed in the specification. *In re Bond*, 910 F.2d 831, 15 USPQ2d

1566 (Fed. Cir. 1990), i.e., the prior art element performs the function specified in the claim in substantially the same manner as the function is performed by the corresponding element described in the specification. (MPEP § 2183.) Clearly the office action fails to show that Barth teaches a “pressure difference adjusting means” under any of these considerations. Therefore, the rejection of independent claims 1 – 4 as being anticipated by Barth cannot withstand scrutiny.

Barth fails to teach or suggest, for example, these elements recited in independent claim 1. It is respectfully submitted therefore that claim 1 as amended is patentable over Barth.

For at least these reasons, the combination of features recited in independent claim 1, when interpreted as a whole, is submitted to patentably distinguish over the prior art. In addition, Barth clearly fails to show other recited elements as well.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claim 1, but also because of additional features they recite in combination.

New claims 5 – 13 have been added to further define the invention, and are believed to be patentable for reasons including those set out above. Support for new claim 5 is located for example in FIG. 1; support for claims 6 and 11 is located for example in FIGs. 2A – 2B; support for claims 7 – 8 and 12 – 13 is located for example in FIGs. 1A-1B; support for new claim 9 is located for example in page 9, lines 10 – 19. Support for new independent claim 10 is located for example in page 1, lines 7 – 10; FIG. 1A-1C, and accompanying description; and page 9, lines 10 – 19.

Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the

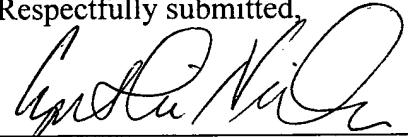
cited prior art shown any of the elements recited in the claims. However, applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, applicant has provided examples of why the claims described above are distinguishable over the cited prior art.

In view of the foregoing, the applicant respectfully submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,



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